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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/964,754 | 09/28/2001 | Yoshihiro Itoh | 05905.0153 | 3110 |
| 7590 | 01/08/2004 | | EXAMINER | |
| Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315 | | | LABAZE, EDWYN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2876 | |

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/964,754 | ITOH ET AL. | |
| | Examiner | Art Unit | |
| | EDWYN LABAZE | 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 26-43 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 26-43 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. Receipt is acknowledged of amendments filed on 10/30/2003.
2. Claims 26-43 are presented for examination.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 26-43 are rejected under 35 U.S.C. 102(b) as being anticipated by DeLorme et al. (U.S. 5,948,040).

Re claim 26, 32, 37, 39 and 41: Delorme et al. discloses travel reservation information and planning system, which includes means of registering a user's personal information by utilizing a portable terminal (which could be a Personal Digital Assistant/PDA 125, or Wireless Communication Unit/WCU 907 as shown in Figs. # 1A & 9B of DeLorme et al. and col.15, lines 40+; col.72, lines 1+); means for creating an electronic coupon bar code by presuming the user's tastes according to the user's personal information registered in the personal database, by preparing the electronic coupon content that suits the user's tastes and by encoding the prepared electronic coupon content (col.8, lines 49-67; col.9, lines 1+); means for delivering image data [using the Global Positioning System/GPS link 903/909 as shown in fig.# 9A of DeLorme et al.], including the electronic coupon bar code, to the user's portable terminal 125/907 (col.15, lines 1-67; col.16, lines 1-59), wherein the portable terminal 125/907 comprises a storage means 912 for

storing the delivered image data and a displaying means for displaying the image [which could be an electronic map as shown in figs. # 1B-(1, 3); 1C; 5D of DeLorme et al.] data (as disclosed in fig. # 9A of DeLorme et al.; col.72, lines 44-67), and wherein an information processing terminal having a bar code reader reads, using its bar code reader, the electronic coupon bar code contained in the image data displayed on the display means of the portable terminal, recognizes the electronic coupon content according to the electronic coupon bar code that has been read, performs the necessary processing to provide a service according to the see recognized electronic coupon content (col.14, lines 62+), and sends new personal information generated by the service to the server so that the new personal information is reflected in the see electronic coupon content for a next delivery (col.59, lines 35-67; col.63, lines 33-67 and col.64, lines 1-44), further includes a first personal database 213 for registering the user's personal information sent from the portable terminal 125/907 (see fig. # 3 of DeLorme et al.; col.34, lines 5-25), a second personal database for registering the user's purchase history sent from the information processing terminal (col.10, lines 34+; col.12, lines 5-48) and means for creating a membership [through user/member registration 852] bar code by encoding the user's personal information registered in the first personal database (col.34, lines 26+).

Re claim 27, 33 and 38: DeLorme et al. teaches a system and method, wherein the means for creating the electronic coupon bar code creates an electronic coupon bar code including a user [Object] ID code for the user (as shown in fig. # 3 of DeLorme et al.; col.32, lines 1+), wherein the information processing terminal specifies the user by reading, using its bar code reader, the electronic coupon bar code displayed on the display means of the portable terminal, and specifies a product selected by the user by using the bar code reader, and sends information

about the user's selected product according to the specified user and product (col.8, lines 62+), and wherein the server registers the received information about the user's selected product and presumes the user's tastes [based on personal information upon registration of the user, previous history or membership background] according to a purchase history of the user so that said presumption of the user's tastes is reflected in the electronic coupon content for the next delivery (col.7, lines 54-67 and col.8, lines 1-67).

Re claim 28: DeLorme et al. discloses a system and method, which includes a machine-readable storage medium [CD ROM] having a program/software stored therein for causing a computer 105 to download data in the service proving system (col.123, lines 58-67; col.14, lines 1+).

Re claim 29 and 34: DeLorme et al. teaches a system and method, wherein the server specifies the electronic coupon content for the next delivery on the basis of the user's purchase history in the personal database, so that a better service [or special offers] rate will be provided with regard to products having a high purchase frequency (col.39, lines 1-67; col.40, lines 1-67; col.41, lines 1-67; col.1-67).

Re claim 30 and 35: DeLorme et al. discloses a system and method, wherein the server specifies the electronic coupon content for next delivery on the basis of the information, which is registered in the product information database, regarding products for which a seller wants to increase sales, and on the basis of the user's purchase history in the personal database (col.53, lines 45-67; col.54, lines 1-67 and col.55, lines 1-19).

Re claim 31: DeLorme et al. teaches a system and method, wherein when the received bar code of the product purchased by the user corresponds to an identification of a previously

determined discount product, the server notifies the information processing terminal of an electronic coupon bar code to allow application of the discount to the price of the product purchased by the user (col.49, lines 1-67 and col.50, lines 1-67).

Re claim 36: DeLorme et al. discloses a system and method, wherein when the received bar code of the product purchased by the user corresponds to an ID code [unique transaction code as shown I fig. # 3 of DeLorme et al.] of a previously determined discount product, the server notifies the information processing terminal of the electronic coupon bar code to allow the discount on the price of the product purchased by the user (col.50, lines 40+; col.67, lines 1-67 and col.68, lines 1-32).

Re claim 40: DeLorme et al. teaches a system and method capable of conducting communication between a portable terminal 907 and a server through a communication line 903 (as shown in fig. # 9 of DeLorme et al.), wherein the server [through PC 105] comprises means for creating an electronic coupon bar code by specifying specific electronic coupon content (col.8, lines 49-67; col.9, lines 1+) and means for delivering image data, including the electronic coupon bar code, user's portable terminal 907 [using the Global Positioning System/GPS link as shown in fig.# 9 of DeLorme et al.], and wherein the potable terminal 907 comprises means for receiving [through GPS 908 and 903 as shown in fig. # 9A] the delivered image data (col.73, lines 1-67; col.74, lines 1-67); means for storing [through memory 912] the received image data (col.72, lines 53+); and means for displaying the image data (col.76, lines 30-67), and wherein an information processing terminal having a bar code reader reads, with its bar code reader, the electronic coupon bar code contained in the image data displayed on the display means of the portable terminal, recognizes the electronic coupon content according to the electronic coupon

bar code, and performs the necessary processing to provide a service according to the service recognized electronic coupon content (col.59, lines 35-67; col.63, lines 33-67 and col.64, lines 1-44).

Re claim 42: DeLorme et al. discloses a system and method, wherein the server presumes the user's tastes according to the user's personal information registered in the first personal database and the purchase history information stored in the second personal database specifies, among the product information database, the product that suits the user's presumed tastes, and delivers information about the specified product via e-mail to the user's portable terminal (col.63, lines 33-67; col.64, lines 1-44).

Re claim 43: DeLorme et al. teaches a system and method, wherein when the user's tastes are presumed according to the user's personal information registered in the first personal database and the purchase history information stored in the second personal database and when the product contained in the received purchase history information is the product that suits the user's presumed tastes, the server changes the service content specified among the product information database to the content more advantageous to the user, and then sends such changed content to the information processing terminal (col.52, lines 4-67; col.53, lines 1+).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jovicic et al. (U.S. 5,855,007) discloses electronic coupon communication system.

Barnett et al. (U.S. 6,336,099) teaches method and system for electronic distribution of product redemption coupons.

Mankoff (U.S. 6,385,591) discloses method and system for electronic organization of coupons.

Ferber et al. (US 2002/0004746) teaches e-coupon channel and method for wireless delivery of e-coupons to wireless devices.

Kitaura et al. (US 2002/0091569) discloses electronic coupon system.

Jokimen et al. (US 2002/0095333) teaches real-time wireless e-coupon definition based on available segment.

Mankoff (US 2002/0116271) discloses electronic delivery of coupons to personal digital assistants.

Naoki et al. (JP 2002/207907) discloses data transmission and reception.

(JP 2002-199503) teaches electronic coupon management server for electronic coupon system, transmits e-coupon stored as bar code information to user terminal provided with bar code scanner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (703) 305-5437 [or (571) 272-2395 which will be effective as of January 15, 2003]. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Art Unit: 2876

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

e1
Edwyn Labaze
Patent Examiner
Art Unit 2876
December 22, 2003



THIEN M. LE
PRIMARY EXAMINER